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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,078	09/27/2004	Mahood Ahmend	P33024	1354

20462 7590 04/09/2007  
SMITHKLINE BEECHAM CORPORATION  
CORPORATE INTELLECTUAL PROPERTY-US, UW2220  
P. O. BOX 1539  
KING OF PRUSSIA, PA 19406-0939

EXAMINER
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BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/509,078

Applicant(s)

AHMEND ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

The abstract of the disclosure is objected to because it does not convey the structural makeup of compound being claimed. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: There are **many** pages with very faint or illegible text. A substitute specification is needed along with a statement by applicants or their representative that no new matter is being introduced.

Appropriate correction is required.

Claims 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. In reviewing the specification it is noted that the compound being claimed in claims 35-37 is the same, namely Form II. Thus reciting individual properties in separate claims is not seen to further distinguish the scope. If applicants disagree they need to point out the differences in scope.

Claims 33-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way

as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Treating Alzheimer's *per se* is not enabled by sole reliance on compound's ability to act as a 5-HT<sub>6</sub> antagonist. The notion that simply having the ability to antagonize at 5HT<sub>6</sub> receptor sites will enable the treatment of neurological disorders such as Alzheimer's has not been substantiated by the current state of the art. See Robichaud or Bromidge as examples of the current state of the serotonin receptor art. Enhancing cognitive memory in Alzheimer's patients is consistent with the teaching of Bromidge as well as Rogers. Otherwise, there is no teaching that treating Alzheimer's *per se* can be effected by such a class of antagonists. Note Rogers discusses the possibility of enhancing cognitive processes which in turn would provide **symptomatic** treatment for dementia. See p.114, right column. Note Genentech vs. Novo Nordisk 42 USPQ 2d 1001 especially left column at p.1005.

Note the criteria for enablement as set out in *In re Wands* cited in MPEP 2164.01(a), August 2000 edition. Thus given the level of skill in this art which is low (for the treatment of Alzheimer's in general and based on 5-HT<sub>6</sub> antagonists in particular ) and the lack of direction (i.e. art-

recognized tests) provided as to what might be treatable and in what dosage compounds are to be administered, this rejection is being applied.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-32, and 35-37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 13 and 21 of copending Application No. 10/509077 (recently allowed). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are structurally similar

being adjacent position isomers. The phenylsulfonyl group in the copending case is at the 4-position vs instant 3-position. Position isomers are not deemed patentably distinct absent evidence of superior, unexpected results. See *In re Crounse* 150 USPQ 554; *Ex parte Engelhardt* 208 USPQ 343 regarding position isomerism.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The IDS filed 9/27/04 has not been considered as no references are seen in the electronic file. For IDS filed 10/10/06 the following are not seen: GB'805; CA'231; GB'549 and WO'157. Copies are thus needed for consideration of entire IDS statements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Emily Bernhardt  
Primary Examiner  
Art Unit 1624